

REMARKS/ARGUMENTS

Favorable reconsideration of this application is respectfully requested.

Claims 1-8 are pending in this application. Claims 1 and 5 have been amended to better indicate that providing the claimed inter-wire distance between wires wound on the common-mode filter core is done in a manner that no part of any wound wire, including any insulating portion of a wound wire, contacts any other part of any other wound wire, as clearly illustrated and clearly supported by FIGS. 1, 2, and 4, for example. In addition, Claim 1 now recites that the width of the separation protrusion is greater than the inter-wire distance, which is suggested by page 9, lines 9-10. Thus, it is clear that the present Amendment adds no new matter.

1. Amendment Entry Under 37 CFR § 1.116

Moreover, as the plane meaning of the term wire, as used in the specification and as found in any dictionary, includes any insulation provided around the electrically conductive portion thereof, it is clear that the language added to Claims 1 and 5 is cosmetic in nature and merely highlights this plane meaning of the term "wire." The PTO was required by precedent to already use the plane meaning of the term "wire" as including any insulation in interpreting Claims 1 and 5. *See In re Morris*, 127 F.3d 1048, 1054, 44 USPQ2d 1023, 1027 (Fed. Cir. 1997) (" [T]he PTO applies to the verbiage of the proposed claims the broadest reasonable meaning of the words in their ordinary usage as they would be understood by one of ordinary skill in the art") and *In re Bond*, 910 F.2d 831, 833, 15 USPQ2d 1566, 1567 (Fed. Cir. 1990) ("It is axiomatic that, in proceedings before the PTO, claims in an application are to be given their broadest reasonable interpretation consistent with the specification, . . . and that claim language should be read in light of the specification as it would be interpreted by one of ordinary skill in the art ."). Accordingly, it is believed that the changes to Claims 1 and 5 do not require any new search or other examination

considerations based upon the clarification that the claim term “wire” previously in Claims 1 and 5 was required to be interpreted to be consistent with its “ordinary usage” and “consistent with the specification,” i.e., that insulated wires are “wires.” The present Amendment is, thus, submitted to be appropriate for entry under 37 CFR § 1.116.

2. Withdrawal of Finality

Moreover, the present rejection has been improperly made final because this Action presents what is essentially a new ground of rejection that has completely changed the thrust of the rejection as set forth in the previous Office Action. In this regard, page 2 of the last Action stated that FIG. 4 of Aoki ‘730 “discloses the same common-mode filter except at least two wires are wound in a manner that an inter-wire distance exists between two wires (the wires 4 are also spaced apart, i.e., pitch)” (emphasis added as to the usage of the words “wire,” “inter-wire,” and “wires”). This portion of the last Action went on to note that FIGS. 10(a)-10(c) of Aoki ‘730 were relied on to show “two conductive wires 4 separated by an inter-wire distance” (emphasis added as to the usage of the words “inter-wire” and “wires”). Clearly the insulated wires 4 of Aoki ‘730 were being interpreted consistent with “ordinary usage” to include any outer insulation and the concept of such wires 4 being separated by an inter-wire distance was then interpreted as requiring the showing of an actual space between the insulated outer coverings of wires 4 as in FIGS 10(a)-10(c) of Aoki ‘730.

These previous interpretations have all been modified by the outstanding Action to give the rejection a different basic thrust by giving a completely different interpretation of the claimed wires and what constitutes the wires 4 of Aoki ‘730. Thus the outstanding Action attempts to withdraw the clear statement of the last Action that FIG. 4 of Aoki ‘730 “discloses the same common-mode filter except at least two wires are wound in a manner that an inter-wire distance exists between two wires” and replace it with the new thrust that “it is unclear as to whether at least two wires are wound in a manner that an inter-wire distance

exists between two wires” because “wires 4 (fig. 4) inherently possesses [sic, possess] an inter-wire distance between the two/pair of wires (i.e., each insulated wire has a center conductive wire, thus there is an inter-wire distance between the pair of center conductive wires 4).” Clearly, the completely new thrust in the rejection is that the wires 4 of FIG. 4 of Aoki ‘730 can now be interpreted as inherently being separated by an inter-wire distance because the insulation around the central conductor of each wire 4 prevents contact between the central conductors even though this insulation clearly does not prevent contact between the insulation around each of these central conductors. Accordingly, as such a change in the basic thrust of the rejection is a new ground of rejection (see *In re Konig*, 539 F.2d 1300, 1302-03, 190 USPQ425, 426-27 (CCPA), the outstanding Action could not be properly made final. Accordingly, withdrawal of the finality of the outstanding Action is submitted to be in order.

3. Outstanding Action Summary

The outstanding Office Action includes a rejection of Claim 1 under 35 U.S.C. § 103(a) as being unpatentable over Aoki (JP 2003-077730, Aoki ‘730), a rejection of Claim 2 under 35 U.S.C. § 103(a) as being unpatentable over Aoki ‘730 in view of Kimura et al. (U. S. Patent No. 6,348,850, Kimura), a rejection of Claim 3 under 35 U.S.C. § 103(a) as being unpatentable over Aoki ‘730 in view of Aoki et al. (U. S. Patent No. 6,535,095, Aoki ‘095), a rejection of Claim 4 under 35 U.S.C. § 103(a) as being unpatentable over Aoki ‘730 in view of Aoki et al. (JP 2002-075722, Aoki ‘722), a rejection of Claim 5 under 35 U.S.C. § 103(a) as being unpatentable over Aoki ‘730 in view of Wada (JP 02042705), a rejection of Claim 6 under 35 U.S.C. § 103(a) as being unpatentable over Aoki ‘730 in view of Wada in further view of Kimura, a rejection of Claim 7 under 35 U.S.C. § 103(a) as being unpatentable over Aoki ‘730 in view of Wada in further view of Aoki ‘095, and a rejection of Claim 8 under 35

U.S.C. § 103(a) as being unpatentable over Aoki '730 in view of Wada in further view of Aoki '722.

4. Summary of the Invention

Base Claim 1 subject matter includes a common-mode filter with a drum type core including a core portion and a pair of flange portions. Electrodes are provided on the pair of flange portions. A pair of wires is wound on the core portion. Each of the flange portions has a groove between corresponding two of the electrodes, and a separation protrusion for separating the groove into two. The pair of wires is wound on the core portion of the drum type core in a distributed winding manner so as to provide an inter-wire distance between the pair of wires with no part of any wound wire, including any insulating portion of a wound wire, contacting any other part of any other wound wire while also providing a winding pitch between adjacent turns of each of the pair of wires. The pair of wires is one-by-one led out through the grooves formed to facilitate lead out while separated by the separation protrusions so that the ends of the pair of said wires are connected to respective ones of the electrodes.

The subject matter of base Claim 5 includes, *inter alia*, a core portion of the drum type core having a plurality of positioning convex or concave portions formed for positioning the pair of wires so that no part of any wound wire, including any insulating portion of a wound wire, contacts any other part of any other wound wire while also keeping the pitch between the pair of wires constant.

5. Rejection Traversals

Turning to the rejection of Claim 1 under 35 U.S.C. § 103(a) as being unpatentable over Aoki '730 it is first noted that the outstanding Action appears to be confused as to the plane meaning of the term wire and as to what Aoki '730 discloses as to elements 4. In this

regard, and as noted above, page 2 of the outstanding Action suggests that it is “unclear” if the wires 4 of Aoki ‘730 are inherently separated by the insulation around each wire such “that an inter-wire distance exists between two wires.” This interpretation can only be arrived at if the center conductive portion of each wire 4 of Aoki ‘730 is arbitrarily called a wire, something not done or suggested by the disclosure of Aoki ‘730. Accordingly, the only unclarity as to what Aoki ‘730 teaches as to the complete make-up of each wire 4 as including the insulator and conductor portions is being suggested by the PTO, not by the reference. Moreover the outstanding Action itself acknowledges that the plane meaning of the term “wire” includes any insulation formed as a part of the wire. See page 6, lines 14-18. However, this acknowledgement is then ignored by the outstanding Action that improperly attempts to limit the meaning of the term “wire” to the “center conductive wire” of an “insulated wire” at pages 2 and 6 of the outstanding Action. This attempted misinterpretation is then compounded at page 7, lines 11-13, of the outstanding Action that suggests that because “[e]ach insulated wire has a center conductive wire [once again, this is PTO terminology not found in Aoki ‘730] covered with insulation . . . there will be a space (i.e., inter-wire distance) between two center conductive wires due to the insulation.”

Besides this unreasonable interpretation that the insulation of the insulated wires 4 of Aoki ‘730 can be equated to the claimed inter-wire distance between the claimed wires, the paragraph on page 2 of the outstanding Action treating Claim 1 and page 7, lines 13-16, of the outstanding Action then somehow equate this separation that is provided by contacting insulating coverings over the conductive central portions of the wires of FIG. 4 with the complete wire separation of FIG. 10, apparently because the same reference number 4 is used. This rationale once again ignores the point raised in the last response that this is not reasonable because the reason for the “improvements” related to FIG.4 was to correct the problems noted as to the “conventional” showing of FIG. 10.

In any event, whatever the theory of the outstanding Action at pages 2 and 6-7, it is clearly incorrectly based upon reading the insulation portion of each of the insulated wires 4 of FIG. 4 of Aoki '730 as teaching that these insulated wires are somehow separated by an inter-wire distance.

Clearly this incorrect reading of wire insulation surrounding the conductor of the wire as providing an inter-wire distance cannot be maintained as to Claims 1 and 5 in light of the present amended language of these claims. In this respect, Claims 1 and 5 now require the term "wire" be given its customary meaning by requiring that the "inter-wire distance between said wires is provided so that no part of any wound wire, including any insulating portion of a wound wire, contacts any other part of any other wound wire." Thus, to whatever extent the outstanding Action has relied upon the insulation between center portions of wires as teaching providing inter-wire distances, this is no longer possible.

Claim 1 also recites that the separation protrusion has a width greater than the inter-wire distance, subject matter that is not taught or suggested by Aoki '230.

Furthermore, even if it were assumed that each insulated wire of FIG. 4 of Aoki '730 includes a "center conductive wire" as noted in the outstanding Action, and even if the present claim language of Claims 1 and 5 as to the "inter-wire distance between said wires is provided so that no part of any wound wire, including any insulating portion of a wound wire, contacts any other part of any other wound wire" is ignored, the fact remains that the teaching of FIG. 4 of Aoki '730 is to position each central wire as close to the adjacent central wire as the surrounding insulation permits. This is contrary to the actual spacing between insulated wires shown by FIG. 10 of Aoki '730. Once again, it is clearly not logical or rational to suggest that the artisan would be led by the disclosure set forth by Aoki '730 to abandon the Aoki improvements of FIG. 4 to adopt the less desirable conventional subject matter of FIG. 10 that Aoki '730 sets forth to be inferior as to the specifically noted problems.

In this last respect, *In re Kotzab*, 217 F.3d 1365, 1371, 55 USPQ2d 1313, 1317 (Fed. Cir. 2000) is once again noted as establishing that:

While the test for establishing an implicit teaching, motivation, or suggestion is what the combination of [reference statements] would have suggested to those of ordinary skill in the art, the [reference] statements cannot be viewed in the abstract. Rather, they must be considered in the context of the teaching of the entire reference. Further, a rejection cannot be predicated on the mere identification in [the reference] of individual components of claimed limitations. Rather, particular findings must be made as to the reason the skilled artisan, with no knowledge of the claimed invention, would have selected these components for combination in the manner claimed. (Emphasis added.)

Here, the rationale offered in the outstanding Action is further deficient because it simply presumes that the spacing of FIG. 10 would be adopted to modify that of FIG. 4 because each discloses that wire 4 is used to make the entirely different windings taught as to these figures.

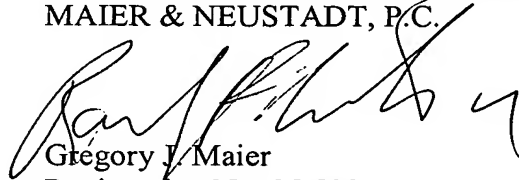
As the PTO has, thus, once again failed to provide any reasonable explanation as to what would have led the artisan to modify the winding of wires 4 of FIG. 4 of Aoki '730 based upon the showing of the different winding of wires 4 in FIG. 10 thereof, it is submitted that no *prima facie* case of obviousness has been established as to the subject matter of Claim 1, and for this reason and all of the above noted reasons, it is again urged that this improper rejection be withdrawn.

The 35 U.S.C. § 103(a) rejections of Claims 2-8 all similarly rely on Aoki '730 as the linchpin to establish obviousness when considered with one or more of Kimura, Aoki '095, Aoki '722, and Wada. However, none of Kimura, Aoki '095, Aoki '722, and Wada considered alone or together in any proper combination cure the deficiencies noted above as to Aoki '730, these 35 U.S.C. § 103(a) rejections of Claims 2-8 are all traversed for the reasons noted above as each of these claims include at least the subject matter added to Claim 1.

As no further issues are believed to remain outstanding in the present application, it is believed that this application is clearly in condition for formal allowance and an early and favorable action to that effect is, therefore, respectfully requested.

Respectfully submitted,

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A handwritten signature in black ink, appearing to read 'Gregory J. Maier', is written over the printed name.

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